



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/509,695	09/20/2000	George Henry Dodd	186618 (8830-210)	7700

7590 02/08/2006

Gregory J. Lavorgna  
Drinker Biddle & Reath LLP  
One Logan Square  
18th & Cherry Streets  
Philadelphia, PA 19103-6996

EXAMINER

PAK, JOHN D

ART UNIT PAPER NUMBER

1616

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



## UNITED STATES DEPARTMENT OF COMMERCE

## U.S. Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
---------------------------------	-------------	---	---------------------

09/509,695

9/20/2000

Dodd

EXAMINER

PAK, J.

ART UNIT

PAPER

1616

02072006

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

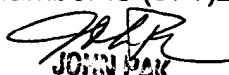
Commissioner for Patents

Applicant argues in the reply of 11/23/2005 that the lack of unity requirement is improper because of myriad reasons, including the reason that "lack of unity needs only to be considered with respect to [independent] claim 1." This is a most restrictive and arbitrary view of lack of unity requirement. The very fact that a Markush practice lack of unity requirement is permitted means that lack of unity is not improper within dependent claims for Markush practice. MPEP 1850.

However, without needing to go on about the propriety of the lack of unity requirement of record, which applicant so vigorously traverses in the reply of 11/23/2005, said requirement is hereby withdrawn. Procedurally, what is then left is an amendment by applicant which completely changes the subject matter that was previously examined in the Office action of Paper No. 8. The following then is the proper procedure after the lack of unity of requirement is withdrawn.

The reply filed on 11/23/2006 is not fully responsive to the prior Office Action on the merits because of the following omission(s) or matter(s). After the lack of unity requirement is withdrawn, what is left is applicant's reply to the previous Office action on the merits that in effect shifts the subject matter under examination to another invention. The shift is not permitted. MPEP 819. The originally claimed invention already required an examination on the merits of a composition that comprised at least one volatile steroid of the androstene family. Presently claimed subject matter represents an improper shift, because the presently claimed subject matter does not recite the previously required at least one volatile steroid of the androstene family. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is (571)272-0620. The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Gary Kunz, can be reached on (571)272-0887. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

  
JOHN PAK  
PRIMARY EXAMINER  
02072006